

REMARKS

The Final Office Action mailed on January 25, 2008 has been noted and its contents carefully studied. The undersigned representative respectfully requests reconsideration in light of these remarks and foregoing amendment.

Claims 1-33 are pending in the present application. Claims 1, 3-9, 13, 14, 23, 24, 28, 30-31, and 33 are rejected as anticipated under 35 U.S.C. § 102(e) and claims 2, 15-22, 25-27, 29, and 32 are rejected as obvious under 35 U.S.C. § 103(a).

Claim Amendments

Independent claim 1 is amended to clarify:

wherein satisfying the obligation further comprises placing a payment in satisfaction of the obligation in a holding account solely for retrieval via an automated teller machine (ATM) by the second party. (Application, 14:21-15:4 and Fig. 13).

Independent claim 28 is similarly amended, and claims 2 and 29 are amended to address editorial issues raised by the amendment of claims 1 and 28. Support for the amendment is found throughout the specification and claims and as noted above and no new matter has been added.

Rejection of Claims 1, 3-9, 13, 14, 23, 24, 28, 30-31, and 33 under 35 U.S.C. § 102(e)

Claims 1, 3-9, 13, 14, 23, 24, 28, 30-31, and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,332,134 to Foster ("Foster"). The rejection is respectfully traversed and reconsideration is requested. Foster does not disclose each and every element of the pending claims in at least the following respects:

Foster fails to disclose "if the first party does not have an account with the third party, by establishing an account for use in at least the electronic transaction," as recited in claims 1 and 28. In claims 1 and 28, the respective method and system allow for the first party (*e.g.*, a consumer) to establish a new account with the third party (*e.g.*, a bank) if the first party does not already have an account with the third party. Unlike conventional methods, however, the new

account can be established with the third party *after* “receiving payment instructions electronically from the first party by a third party.”

In contrast, Foster recites a system where a first party (*e.g.*, a cardholder) only has an account with a third party (*e.g.*, a card company), but does not disclose establishing a new account after the payment instructions. “[A] cardholder makes a purchase from a merchant using credit *established* at a financial institution.” Foster 2:67-3:2 (emphasis added). Thus, in Foster, the credit must already be established, *i.e.*, a credit card account must already exist. In fact, Foster only refers to the first party as a “cardholder” because the party must already have a credit card with the third party. Therefore, Foster does not disclose each and every element of claims 1 and 28.

Moreover, the foregoing amendment of claims 1 and 28 clarifies “wherein satisfying the obligation further comprises placing a payment in satisfaction of the obligation in a holding account solely for retrieval via an automated teller machine (ATM) by the second party”. As admitted by the examiner, Foster fails to teach or suggest the second party receiving payment via an automated teller machine.

Because each and every element as set forth in independent claims 1 and 28 is not found, either expressly or inherently in the cited reference, the examiner has failed to establish the required *prima facie* case of unpatentability. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628 (Fed. Cir. 1987); See also MPEP §2131. The examiner has failed to establish the required *prima facie* case of unpatentability for independent claims 1 and 28 and similarly has failed to establish a *prima facie* case of unpatentability for claims 3-9, 13, 14, 23, and 24 that depend on claim 1, and claims 30-31, and 33 that depend on claim 28, and which recite further specific elements that have no reasonable correspondence with the reference.

Rejection of Claims 2, 15-18, 25-27, 29, and 32 under 35 U.S.C. § 103(a)

Claims 2, 15-18, 25-27, 29, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of U.S. Patent Publication No. 2002/0016769 to Barbara et al. (“Barbara”). The rejection is respectfully traversed and reconsideration is requested. As noted above, Foster fails to teach or even suggest the required combinations of independent claim 1 on

which claims 2, 15-18, and 25-27 depend and/or independent claim 28 on which claims 29 and 32 depend. The proposed modification of Foster in view of Barbara lacks one or more limitations recited in each of independent claims 1 and 28, and there is inadequate articulated reasoning with rational underpinning to support the Examiner's legal conclusion of obviousness in at least the following respects:

Barbara fails to teach or suggest wherein satisfying the obligation further comprises placing a payment in satisfaction of the obligation in a holding account solely for retrieval via an automated teller machine (ATM) by the second party, as recited in amended claim 1 on which claims 2, 15-18, and 25-27 depend and independent claim 28 on which claims 29 and 32 depend. On the contrary, instead of a holding account for the sole purpose of retrieval by the second party via an ATM, Barbara teaches a "transaction account 30" that is provided for a bank customer with a bank account number and an associated ATM card and which is expressly described in Barbara as a "depository account subject to all of the rules and regulations of any bank account" and with many typical bank account features plus additional features (See, e.g., Barbara par. [0059]).

Consequently, the claimed combinations recited in independent claims 1 and 28 are not taught or suggested by Foster and/or Barbara either separately or in combination with one another. Because the cited references, either alone or in combination, do not teach the limitations of independent claims 1 and 28, the examiner has failed to establish the required *prima facie* case of unpatentability. See *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); see also MPEP § 2143.03. Similarly, the examiner has failed to establish a *prima facie* case of unpatentability for claims 2, 15-18, and 25-27 depending on claim 1 and claims 29 and 32 depending on claim 28 and which recite further specific elements that have no reasonable correspondence to the references.

Rejection of Claims 10-12 under 35 U.S.C. § 103(a)

Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Balto, "Creating a Payment System Network: The Tie That Binds or an Honorable Peace?" ("Balto"). The rejection is respectfully traversed and reconsideration is requested. As

noted above, Foster fails to teach or even suggest the required combinations of independent claim 1 on which claims 10-12 depend. The proposed modification of Foster in view of Balto, which discusses collusion issues in connection with VISA interchange fees, lacks one or more limitations recited in independent claim 1, and there is inadequate articulated reasoning with rational underpinning to support the Examiner's legal conclusion of obviousness.

Consequently, the claimed combinations recited in independent claim 1 are not taught or suggested by Foster and/or Balto either separately or in combination with one another. Because the cited references, either alone or in combination, do not teach the limitations of independent claim 1, the examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); see also MPEP § 2143.03. Similarly, the examiner has failed to establish a *prima facie* case of unpatentability for claims 10-12 depending on claim 1 and which recite further specific elements that have no reasonable correspondence to the references.

Rejection of Claims 19-22 under 35 U.S.C. § 103(a)

Claims 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Bowen, "Behind the Spree in Payments for C2C" ("Bowen"). The rejection is respectfully traversed and reconsideration is requested. As noted above, Foster fails to teach or even suggest the required combinations of independent claim 1 on which claims 19-22 depend. The proposed modification of Foster in view of Bowen, which discusses insurance and escrows, lacks one or more limitations recited in independent claim 1, and there is inadequate articulated reasoning with rational underpinning to support the Examiner's legal conclusion of obviousness.

Consequently, the claimed combinations recited in independent claim 1 on which claims 19-22 depend are not taught or suggested by Foster and/or Bowen either separately or in combination with one another. Because the cited references, either alone or in combination, do not teach the limitations of independent claim 1, the examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); see also MPEP § 2143.03. Similarly, the examiner has failed to establish a

prima facie case of unpatentability for claims 19-22 depending on claim 1 and which recite further specific elements that have no reasonable correspondence to the references.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

Date: April 24, 2008
KING & SPALDING LLP
1700 Pennsylvania Ave., NW
Washington, DC 20006
(202) 737-0500

By: /John M. Harrington - Reg. #25,592/
John M. Harrington
Registration No. 25,592